

Application No.: 10/685,406
Art Unit: 3611

Attorney Docket No. 23380.00
Confirmation No. 7856

REMARKS

By the present amendment, Applicant has amended Claims 1 – 6, 8, 9, 12, 13 and 16, and cancelled Claims 7 and 10. Claims 1-6, 8, 9 and 11-17 remain pending in the present application. Claim 1 is an independent claim.

Applicant appreciates the courtesies extended to Applicant's representative during the personal interview held August 4, 2004. At the interview Examiner Monica S. Carter and Attorney Libby Babu were present. The present response summarizes the substance of the interview. Prior to the interview a proposed amendment was presented to the Examiner for review. Proposed independent Claim 1 set forth additional features of the twelve-month chart and the monthly calendar. Proposed Claims 3, 4 and 5 were amended in the interest of clarification. Arguments were advance that the prior art of record was not applicable against the proposed claims since a new and unobvious functional relationship clearly exists between the printed indicia and the claimed structural elements. The Examiner maintained her position as stated of record and no agreement was reached. However, the Examiner suggested that Applicant's calender be defined structurally to distinguish the invention over the prior art.

In the recent Office Action the Examiner rejected Claims 1-7 and 9-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Stawski, II (U.S. Patent No. 5,573,404). Claim 8 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Stawski, II in view of Selman (U.S. Patent No. 4,852,282).

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Applicant will advance arguments herein below to illustrate the manner in which the presently claimed invention is patentably distinguishable from the prior art of record. Reconsideration of the application is respectfully requested.

Independent Claim 1 has been amended to more particularly define the subject matter in question. Amended Claim 1 sets forth a birthday calendar for recording birthdays and other annual dates, which comprises a single sheet twelve-month chart joined to a monthly calendar such that the calendar and chart are simultaneously visible. The chart is further defined as having vertical and horizontal parallel arranged intersecting lines imprinted thereon to form rows and columns defining a plurality of memorandum spaces for permanently recording therein birthdays and other annually recurring events. The monthly calendar is characterized as having imprinted thereon seven parallel vertical rows intersecting seven parallel horizontal columns defining memorandum spaces for removably imprinting birthdays and other monthly events therein as displayed on the chart. The monthly calendar is further defined as having an erasable surface for reuse from month-to-month. Amended Claim 1 further includes a transparent protective cover removably disposed over the chart element. Applicant's invention provides a convenient means for simultaneously viewing a permanent record of annually recurring significant events in the chart section and a temporary record of associated events in the monthly calendar section.

In contrast, the patent to Stawski realistically discloses a behavior modification chart for modifying the behavior of a child by determining a periodic allowance for the child based on the behavior of the child during a period of a week. Stawski's chart includes relevant information of behavior elements on which

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the weekly allowance is to be calculated, and the chart is laminated with a plastic material that can be erased when marked with a marking instrument. Clearly, Stawski's behavior modification chart is structurally and functionally unrelated to Applicant's calendar, as defined by the present claims. First, the arrangement and content of the printed indicia of Applicant's twelve-month and monthly calendar and Stawski's chart are completely different. Stawski's chart is designed for use over a weekly period, whereas Applicant's calendar provides a permanent record of annually recurring events in the chart section and a temporary record of associated events in the monthly calendar section. The prior art fails to disclose a twelve-month calendar section made of an ink accepting material joined to monthly chart section having an erasable surface. The unique relationship between the annual and monthly recorded information to the structural features of Applicant's calendar enables one to conveniently view both sections simultaneously. Secondly, Applicant's transparent protective cover is removably disposed over only the twelve-month chart section, whereas Stawski's entire chart is laminated and marked upon. Applicant's cover is removable so that birthdays and other annually recurring events may be added to and permanently recorded on the chart section. The monthly calendar section has an erasable surface for reuse from month-to-month.

The Examiner cite *In re Gulack*, 217 USPQ 401, (CAFC1983) in support of the position that "where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability." However, *In re Gulack* also cites that "differences between an invention and the prior art cited against it cannot be ignored merely because those

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differences reside in the content of the printed matter. Under section 103, the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole.” *In re Gulack*, 217 USPQ 403. In addition *In re Gulack* went further to say that “the bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.” *In re Gulack*, 217 USPQ 404.

Applicant contends that the primary reference to Stawski fails to suggest Applicant’s unique relationship between the physical structure and the printed matter of the claimed calendar. There exists a definite cooperative relationship between the printed matter and structural features of the calendar, without which it would not be possible to record annual events in the chart section, cover this section with a protective cover, and eraseably imprint corresponding monthly events in the monthly calendar section, while viewing both sections together. Applicant’s invention constitutes a new and unobvious functional relationship between the calendar and the indicia imprinted on the co-joined sections. Applicant contends that the presently amended claims properly define this relationship. *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969) held that patentability of an invention may be based on printed matter when there is a functional relationship between the printed matter and the substrate.

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For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,



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